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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,470	01/27/2004	Noriko Sugimoto	2004_0109A	9151
513 7590 08/26/2008 WENDEROTH, LIND & PONACK, L.L.P. 2033 K STREET N. W. SUITE 800 WASHINGTON, DC 20006-1021			EXAMINER COPPOLA, JACOB C	
			ART UNIT 3621	PAPER NUMBER
			MAIL DATE 08/26/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/764,470

Applicant(s)

SUGIMOTO ET AL.

Examiner

JACOB C. COPPOLA

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 C.F.R. §1.114

1. A request for continued examination (RCE) under 37 C.F.R. §1.114, including the fee set forth in 37 C.F.R. §1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 C.F.R. §1.114, and the fee set forth in 37 C.F.R. §1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 C.F.R. §1.114. Applicant's submission filed on 14 July 2008 has been entered.

Acknowledgements

2. This action is in reply to the RCE filed 08 August 2008, the Amendments filed on 14 July 2008, and the Applicants' Remarks/Arguments filed on 14 July 2008.
3. Claims 15-21 are currently pending and have been examined.
4. All references to the capitalized versions of "Applicants" refer specifically to the Applicants of record. Any references to lower case versions of "applicant" or "applicants" refer to any or all patent "applicants." Unless expressly noted otherwise, references to "Examiner" refers to the Examiner of record while reference to or use of the lower case version of "examiner" or "examiners" refers to examiner(s) generally. The notations in this paragraph apply to this Office Action and any future office action(s) as well.
5. This Office Action is given Paper No. 20080823. This Paper No. is for reference purposes only.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 15 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamada et al. (U.S. 6,141,483 A) (“Yamada”), in view of Yoshii et al. (U.S. 2003/0090711 A1, now U.S. Patent No. 7,239,417 B2) (“Yoshii”), and in further view of Candelore et al. (U.S. 2003/0174837 A1) (“Candelore”).
8. Regarding claim 15:
- a. Yamada discloses *a playback apparatus for playing back an optical disc* (see column 3, lines 40-49: “reproducing apparatus”). Yamada, further, discloses *a judging unit operable to judge whether a disc region code* (“medium region code”) *assigned to an optical disc matches an apparatus region code assigned to the playback apparatus* (see at least column 3, lines 57-61), *and a reading unit operable to read a content identifier of content recorded on the optical disc* (see at least column 10, lines 16-17: “recorded data is read from the recording medium by an optical pickup”), *and a playback unit operable to, (i) play back the content when the judging unit judges that the disc region code matches the apparatus region code* (see figure 6 and associated text; and column 9, lines 36-39).

- b. Yamada does not specifically disclose *a recording medium operable to store predetermined additional data corresponding to the optical disc, and the recording medium being distinct from the optical disc.*
- c. Yoshii, however, does disclose *a recording medium* (“second distribution means”) *operable to store predetermined additional data* (“secondary data”) *corresponding to a first recording medium* (see ¶0010 and ¶0011), *and the recording medium being distinct from a first recording medium* (see ¶0010 and ¶0011).
- d. Since each individual element and its function are shown in the prior art, albeit shown in separate references, the difference between the claimed subject matter and the prior art rests not on any individual element or function but in the very combination itself – that is in the substitution of the first recording medium of Yoshii for the optical disc of Yamada. Thus, the simple substitution of one known element for another, producing predictable results, renders the claim obvious.
- e. Additionally, Yamada/Yoshii does not specifically disclose *the predetermined additional data including a substitute playback order of the content recorded on the optical disc and including substitute content, the substitute content replacing a predetermined part of the content recorded on the optical disc.*
- f. Candelore, however, does disclose *predetermined additional data including a substitute playback order of the content recorded on an optical disc and including substitute content, the substitute content replacing a predetermined part of the content recorded on the optical disc* (see the abstract, figure 5, and associated text).

- g. One of ordinary skill in the art would have recognized that applying the known technique of Candelore would have yielded predictable results and resulted in an improved system. It would have been recognized that applying the technique of Candelore to the teachings of Yamada/Yoshii would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to incorporate such substitute playback features into similar systems. Further, applying the substitute playback order and substitute content that replace the originals to Yamada/Yoshii with predetermined additional data in relation to an optical disc, would have been recognized by those of ordinary skill in the art as resulting in an improved system that would allow for a higher level of consumer satisfaction.
9. Claims 16-21 are rejected under 35 U.S.C. §103(a) as being unpatentable over Yamada/Yoshii/Candelore, in further view of Applicants' Own Admission ("AOA").
10. Regarding claim 16:
- h. Yamada/Yoshii/Candelore discloses the limitations of claim 15, as described above. Yamada/Yoshii/Candelore, further, disclose *the content includes playlist information, the playlist information is information including one or more pairs of start time information and end time information in a playback time axis of the AV stream, each pair of start time information and end time information defining a playback section* (see Yoshii, ¶0011: "a reproduction start point and a reproduction end point correspond to an image frame-specific code for specifying an image frame of the digital image data"), and *the content includes a dynamic scenario, the dynamic scenario is a program that causes*

the playback apparatus to play back the playlist information (see Yoshii, ¶0011: “such that the second reproduction means leads out the reproduction start point and the reproduction end point corresponding to the image frame to be reproduced during the reproduction of the digital image data”), and *the predetermined additional data* (see Yoshii, ¶0016: “secondary data”) *is any of the AV stream* (see Yoshii, ¶0015: “subtitles”), *the playlist information, and the dynamic scenario supplied to the playback apparatus via a network* (see ¶0016: “the server and the user terminal being connected [to] each other through [the] Internet”), and *the playback of the created predetermined package includes (i) a playback of one of an additional audio stream and an additional subtitle stream that are not recorded on the optical disc* (see Yoshii, ¶0015: “as the secondary data, multimedia such as character, sound, and image can be treated”), and *(ii) a playback of a playback section of the AV stream that is different from the playback section defined by the playlist information of the optical disc* (see figures 3 and 4 – showing the “created predetermined package” containing different data collectively than that of “digital image data 11” (i.e., optical disc)). Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to design a content rendering apparatus, as disclosed by Yamada, to include the ability to render the same data-structure as the rendering apparatus disclosed by Yoshii. One would have been motivated to do so because this would generate higher revenue sales of the apparatus for providing, by design, additional venues for the apparatus to be utilized in.

- i. Yamada/Yoshii/Candelore does not explicitly disclose *the content includes an AV stream, the AV stream is a stream obtained by multiplexing a video stream, an audio stream, and a subtitle stream.*
 - j. AOA, however, discloses that content in the form of an AV stream containing video, audio, and a subtitle stream is old and well-known.
 - k. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to design a content rendering apparatus, as disclosed by Yamada/Yoshii/Candelore, to include the ability to render this well known data structure. One would have been motivated to do so because this would allow the device to play current DVD formats.
11. Regarding claim 17:
- l. Yamada/Yoshii/Candelore/AOA discloses the limitations of claim 16, as described above. Yamada/Yoshii/Candelore/AOA, further, discloses *a playback authorization setting that indicates which playback of the video stream, the audio stream, and the subtitle stream is authorized or not* (see Yamada, column 10, lines 1-15: “coincident password”). Yamada does not specifically disclose *playlist information or the created predetermined package includes a playback authorization setting that is different from the playback authorization setting defined by the playlist information of the optical disc.* Yoshii, however, in Figure 4 discloses playlist information in the form of “Digital Frame-Specific Code” for the “Digital Image Data 11” (i.e., the optical disk). Additionally, Yoshii in Figure 4 discloses playlist information for the “secondary data” in the form of “Reproduction Start Point 32” and “Reproduction End Point 33” that

provides the structure for combining the “Digital Image Data 11” with the “Secondary Data 12”. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to assign a unique playback authorization setting, as disclosed by Yamada, with the each of the playlist information disclosed by Yoshii. One would have been motivated to do so because this would limit additional “secondary data” to only those that are authorized.

12. Regarding claim 18:

m. Yamada/Yoshii/Candelore/AOA discloses the limitations of claim 17 as described above. Yamada, further, discloses further comprising *a transmitting unit operable to transmit an authorization request to a server apparatus, the authorization request indicating the combination of the content identifier read by the reading unit (“requested data contents”) and the apparatus region code (“region code designating the place where the PC is installed”), wherein when the predetermined condition is satisfied, the server apparatus transmits an authorization response in reply to the authorization request (“when region codes coincide with each other, the control unit 93 confirms the IP address of the PC or EWS 95 on the client side contained in the packet of a communication protocol upon reception of a data supply request. After determining the authenticity of the region code, the control unit 93 permits data transfer”), and wherein, when the predetermined condition is not satisfied, the server apparatus transmits a non-authorization response* (see at least column 22, lines 37-56 and FIG. 26 with associated text).

13. Regarding claim 19:

n. Yamada/Yoshii/Candelore/AOA discloses the limitations of claim 18 as described above. Yamada, further, discloses *the server apparatus includes a playback authorization list including combinations of a content identifier and a region code, each combination indicating that a content identified by a respective content identifier is allowed to be played back in a region identified by a respective region code; and the predetermined condition is satisfied when the playback authorization list of the server includes the combination of the content identifier and the apparatus region code indicated by the authorization request transmitted by the transmitting unit* (see at least column 22, lines 37-56 and FIG. 26 with associated text).

14. Regarding claim 20:

o. Yamada/Yoshii/Candelore/AOA discloses the limitations of claim 19 as described above. Yamada, further, discloses *the server apparatus includes a plurality of pieces of date/time information ("copyright use valid time data"), each piece of date/time information indicating, for a corresponding combination of a content identifier and a region code, a release date/time of a content identified by the content identifier for a region identified by the region code of the corresponding combination; the authorization request transmitted from the transmitting unit to the server apparatus includes a combination of (i) a current time in a region to which the playback apparatus belongs, (ii) the content identifier of the content to be played back, and (iii) the apparatus region code; and the predetermined condition is satisfied when the current time included in the authorization request is past the release date/time indicated in a piece of date/time*

information for a corresponding combination of the content identifier and the region code that is the same as the combination of the content identifier and the region code included in the authorization request (see at least column 20, lines 63-67 and column 21, lines 1-22).

15. Regarding claim 21:

p. Yamada/Yoshii/Candlore/AOA discloses the limitations of claim 20 as described above. Yamada, further, discloses the server apparatus includes a plurality of pieces of distributor information, each piece of distribution information indicating, for a corresponding combination of a content identifier and a region code, a distributor for a region identified by the region code of the corresponding combination; the authorization request transmitted from the transmitting unit to the server apparatus includes a combination of (i) the content identifier of the content to be played back, (ii) the apparatus region code, and (iii) the disc region code; and the predetermined condition is satisfied when a distributor indicated in a first piece of distributor information matches a distributor indicated in a second piece of distribution information, the first piece of distributor information indicating a distributor for a corresponding combination of the content identifier and the apparatus region code that is the same as the combination of the content identifier and the apparatus region code included in the authorization request, and the second piece of distributor information indicating a distributor for a corresponding combination of the content identifier and the disc region code that is the same as the combination of the content identifier and the disc region code included in the authorization request (see at least column 16, lines 14-67 and column 17, lines 1-34).

16. The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

17. Regarding the conditional elements in the claims (see *e.g.* claim 15 recites “the playback unit plays back a predetermined package... when the judging unit judges that the disc region code... and when a combination of the content identifier read...”), they too have been considered. However, Applicants are reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See *e.g.* MPEP §2106 II C: “Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.]”

18. In light of Applicants’ choice to pursue product claims, Applicants are reminded that functional recitation(s) using the word and/or phrases “for”, “adapted to”, “configured to”, or other functional language (*e.g.* see claim 15 which recites “a judging unit operable to judge”) have been considered but are given little patentable weight because they fail to add any structural limitations and are thereby regarded as intended use language. To be especially clear, all limitations have been considered. However, a recitation of the intended use of the claimed

product must result in a structural difference between the claimed product and the prior art in order to patentably distinguish the claimed product from the prior art. If the prior art structure is capable of performing the intended use, then it reads on the claimed limitation. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) ("The manner or method in which such a machine is to be utilized is not germane to the issue of patentability of the machine itself."); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). See also MPEP §§ 31.06 II (C.), 2114 and 2115. Unless expressly noted otherwise by the Examiner, the claim interpretation principles in the paragraph apply to all claims currently pending.

Response to Remarks/Arguments

19. Since Applicants did not seasonably traverse the Official Notice statement as stated in the previous Office Action (mail date of 14 April 2008, ¶14), the Official Notice statement is taken to be admitted prior art. See MPEP §2144.03.

20. Applicant's arguments with respect to claim 15 have been considered but are moot in view of the new ground of rejection.

Conclusion

21. In accordance with *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), the Examiner finds that the references How Computers Work, Millennium Ed. By Ron White; How Networks Work, Bestseller Ed. By Frank J. Derfler et al.; How the Internet Works, Millennium Ed. By Preston Gralla; and Desktop Encyclopedia of the Internet by Nathan J. Muller, is additional evidence of what is basic knowledge or common sense to one of ordinary

skill in this art. Each reference is cited in its entirety. Moreover, because these references are directed towards beginners (see *e.g.* "User Level Beginning..."), because of the references' basic content (which is self-evident upon examination of the references), and after further review of the entire record including the prior art now of record in conjunction with the factors as discussed in MPEP §2141.03 (where practical), the Examiner finds that these references are primarily directed towards those of low skill in this art. Because these references are directed towards those of low skill in this art, the Examiner finds that one of ordinary skill in this art must—at the very least—be aware of and understand the knowledge and information contained within these references.

22. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

q. Lamkin et al. (U.S. 2004/0220926 A1) discloses personalization services for entities from multiple sources.

23. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to Jacob C. Coppola whose telephone number is (571) 270-3922. The Examiner can normally be reached on Monday-Friday, 9:00 a.m. - 5:00 p.m. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached at (571) 272-6779.

24. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private

PAIR system, please contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/Jacob C Coppola/

Examiner, Art Unit 3621

August 23, 2008

/ANDREW J. FISCHER/

Supervisory Patent Examiner, Art Unit 3621